

REMARKS

This is in response to a final Office Action mailed October 21, 2003. Applicants respectfully traverse and request reconsideration.

Rejection of claims under 35 U.S.C. §103(a)

Claims 1-2, 4-8, 10-14 and 17-20 currently stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kwoh et al., U.S. Patent No. 6,115,057, ("Kwoh") in view of Ming et al., U.S. Patent No. 5,710,815 ("Ming") and Chapman et al., U.S. Patent No. 6,216,228 B1 ("Chapman").

Applicants respectfully re-submit that Kwoh is directed to, inter alia, a device for blocking the display of a program video segment by replacing the blocked video segment with embedded text in the incoming stream, wherein the text describes the blocked scene if it is determined that the extracted rating data indicates that the program video segment has an unacceptable rating level. As cited by the Examiner in Kwoh, col. 9, lines 5-15, the text information is imbedded within the incoming video signal. Hence, Kwoh discloses the device for substituting the display of the extracted text data representative of the content of the program video segment or the blocked program video segment. This device maintains control of rating levels while providing a means for the viewer to comprehend basic plot events of a censored program during the entire length of the program. The method disclosed by Kwoh requires a video signal that includes both video and corresponding descriptive text data. This method relies on a substitution of text data for blocked video data, and therefore does not require scrambling of video data. In fact, due to the imbedded nature of video and text data, scrambling would result in a loss of text data and therefore render useless the substitution of text for video data in Kwoh's method. Applicants respectfully submit that the Kwoh reference teaches a way for any method of scrambling as a way to prevent viewing of video programs.

Ming is directed to, inter alia, an encoder and decoder for television signals with embedded viewer access controlled data. More specifically, Ming discloses, inter alia, a television broadcast system having a plurality of channel processors 102 that include channel controllers 105 controlling scrambling of associated video television programs. Video frames of

the signal 110 are scrambled by signal encoder 103 under the control of the corresponding channel control using a random line inversion and synchronization suppression technique. In other words, Ming teaches a system, inter alia, in which when a particular signal is not to be viewed, for example, when it is a pay-per-view program and the user has not paid the proper subscription fee or if the cable subscription user is not subscribed to a particular channel, the data formatter and video scramble control 118 generates a scrambled output signal which is provided to an output device.

Chapman is directed to, inter alia, controlling video or image presentation with respect to encoded content classification information provided via an invisible digital watermark. Chapman teaches, inter alia, embedding the digital watermark in a display signal such that the display signal is received and the input video data and ratings are compared with a stored rating system. Chapman teaches utilizing an invisible watermark code embedded within the display signal wherein the watermark is embedded prior to the transmission of the signal to a receiving device.

Rejection of claims 1-2, 4-8, 10-14 and 17-20

Claims 1-2, 4-8, 10-14 and 17-20 currently stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kwoh, in view of Ming and further in view of Chapman. Applicants respectfully traverse and request reconsideration. Under MPEP § 2142, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness, the Examiner must first support a finding of some suggestion or motivation to combine the references, wherein the combination cannot be found within the Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Second, there must be at least some reasonable expectation of success in combining the references, as found within the prior art references and not within the Applicants' disclosure. Id.

A reference should be considered as a whole, in portions arguing against or teaching away from the claimed invention must be considered. Bausch & Lomb, Inc. v. Barnes Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ2d 416 (Fed. Cir. 1986). A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be lead in

a direction divergent from the path that was taken by the Applicant. Tecair, Inc. v. Denso Mfg. Mich. Inc., 192 F.3d 1353, 1360, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999).

Moreover, “[a] showing of a suggestion, teaching, or motivation to combine the prior art references is an essential evidentiary component of an obvious holding.” Brown & Williams Tobacco Corp. v. Phillip Morris, Inc., 229 F.3d 1120, 56 USPQ2d 1456 (Fed. Cir. 2000) citing C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1342 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). The showing of a suggestion, teaching, or motivation to combine prior art references “must be clear and particular.” In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). In essence, the Examiner must shown the motivation to combine the references. In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998).

In the present case, Applicants respectfully submit the present rejection is improper because the prior art references of Kwoh, Ming and Chapman teach away from being combined. The disclosure of Chapman teaches scrambling a portion of a signal based on an embedded watermark. This embedded watermark is disclosed as consisting of a complicated algorithm utilizing signal strength.

Ming teaches of scrambling all signals prior to the transmission. More specifically, Ming is a pre-transmission system used to block specific content. For example, in the Examiner-noted passage on page 7, “a subscriber who wishes to preclude viewing of programming having one or more such attributes may contact the CATV service provider, requesting that any television programming containing such attributes be precluded from being displayed on a video display via the subscribers decoder apparatus. In response, the CATV service provider will periodically insert a user category code having a numeric value indicative of a particular programming content the attributes for which viewing by the particular subscriber is to be precluded.” See Col. 7, lines 38-42. As further illustrated, in FIG. 1, Ming is a broadcast system which provides for embedding of distorted signals through broadcast not through a box reception device.

Therefore, if one of ordinary skill in the art utilize a system of Kwoh, the system is not only a receptive system for receiving an incoming signal, but the system relies on data contained within the incoming signal not watermark data. For example, FIG. 31A, step 910 provides

extract beginning rating data from a program video segment indicating rating level of program video segment and then compared the extracted rating data with the desired rating level, step 912. This is further supported by the specification, the system of Kwoh looks for program identifier in the signal received from the television signal source, wherein the program identifier may be a rating included within the vertical blanking interval timing of the signal. Otherwise, Kwoh teaches a system that filters particular channel such as blocking a particular channel from a multiplexed incoming video signal.

It is submitted that one of ordinary skill in the art would not have been motivated to combine these references because, *inter alia*, the system of Chapman teaches away from being combined with Kwoh as Chapman is directed to a broadcast transmission side of the technology field. Chapman is concerned and is directed to transmitting broadcast information that is scrambled such that a receiver, cannot render the image. The system of Chapman generates a broadcast signal to be broadcast to a set top box, whereas the system of Kwoh would be the set top box itself. In essence, the Examiner is attempting to modify and combine two systems on polar opposite sides of the video broadcasting transmission systems.

Moreover, with the teachings of Ming, Ming is directed to scrambling portions of the signal based on an embedded watermark, wherein Ming discloses extensive procedures and operations for not only generating the watermark but also decoding the specific watermark itself. The system of Kwoh is not designed or capable of handling the watermark, but rather is designed to read a specific data field within the vertical blanking interval or to systematically block a whole channel. It is submitted that the teaching of Ming teaches a system that operates in a completely different manner by utilizing digital watermarks and the usage of the digital watermark in and of itself teaches away from being combined with the system that utilizes vertical blanking intervals. Therefore, one of ordinary skill in the art would not have been motivated to combine these systems because one of ordinary skill in the art would not have been able to combine a digital certificate watermark of Chapman in conjunction with the transmission teachings of Ming and further in conjunction with the VBI based content control of Kwoh.

Therefore, it is respectfully submitted the present rejection is improper as one of ordinary skill in the art would not have been motivated to combine the above-noted references and that the combination thereof would fail to produce the claimed present invention. As such, reconsideration and withdrawal of the present rejection is requested.

Applicants further respectfully resubmit the above position offered with regards to claims 1, 7 and 13. As such, it is submitted that claims 2, 8 and 14 contain further patentable subject matter in view of the prior record and passage to issuance is respectfully requested. Should the Examiner maintain the present rejection, Applicants request a showing, including specific column and line numbers, where either Ming teaches scrambling a portion of the audio content to produce scrambled audio content beyond teaching scrambling audio to be transmitted to a receiving device and/or where Chapman teaches any disclosure regarding scrambling at least a portion of the audio content to produce scrambled audio content and providing the scrambling audio content to an audio rendering device.

Regarding claims 4, 10 and 17, Applicants respectfully resubmit the above positions offered with regards to claims 1, 7 and 13 and further resubmit the position offered with regards to claims 2, 8 and 14 submitting that neither Ming nor Chapman disclose limitations regarding not only scrambling at least a portion of the audio content, but further fail to teach or suggest scrambling the text content to produce scrambled text content and providing the scrambled text content to a display.

Applicants respectfully resubmit the above position offered with regards to claims 1, 7 and 13 and submit that claims 4, 10 and 17 contain further patentable subject matter in view thereof. As such, reconsideration and withdrawal is respectfully requested.

Regarding claims 5-6, 11-12, 18 and 20, Applicants respectfully submit that these claims contain further limitations that are neither taught nor suggested by the combination of prior art references. It is submitted that these claims contain further patentable subject matter and are allowable not merely as being dependent upon the allowable independent base claim, claims 1, 7 and 13, respectively. As such, Applicants respectfully request reconsideration and withdrawal and the passage of these claims to issuance.

Claims 3, 9, 15-16 and 21-22

Claims 3, 9, 15-16 and 21-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kwoh in view of Ming, Chapman and Frederiksen, U.S. Patent No. 4,605,961 ("Frederiksen").

Regarding claims 3, 9, 15-16, 21-22, Applicants respectfully traverse and request reconsideration. Applicants respectfully resubmit the previously offered position regarding the teachings of Frederiksen submitted in the response filed February 3, 2003. Applicants further respectfully submit that claims 3, 9, 15-16 and 21-22 contain further patentable subject matter in view the prior art of record and are allowable not merely as being dependent upon allowable base claim. For example, regarding claims 3, 9 and 15-16, resubmitting the above position offered with regards to claims 1, 7 and 13, Applicants submit that further adding the limitations of attenuating at least a portion of the audio content that produces scrambled audio content would not be taught or suggested by the further inclusion of the teachings of Frederiksen as previously noted above and in the response filed February 3, 2003.

Applicants further respectfully traverse the present rejection as the Examiner has failed to provide any stated motivation for combining the present references of Kwoh, Ming, Chapman and Frederiksen. As such, Applicants request reconsideration and withdrawal. Should the Examiner maintain the present rejection, Applicants request, among other things, a showing of the stated motivation for the combination of the above-noted references in support of the present rejection.

AF Response dated December 22, 2003
Appl. No. 09/169,023
Atty. Docket No. 0100.01272

Accordingly, Applicants respectfully submit that the claims are in condition for allowance and that a timely Notice of Allowance be issued in this case. The Examiner is invited to contact the below-listed attorney if the Examiner believes that a telephone conference will advance the prosecution of this application.

Date: December 22, 2003

Respectfully submitted,

By: 

Timothy J. Bechen
Reg. No. 48,126

Vedder, Price, Kaufman & Kammholz, P.C.
222 N. LaSalle Street
Chicago, IL 60601
Telephone: (312) 609-7500
Facsimile: (312) 609-5005